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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,023	05/30/2001	Charles L. Branch	4002-2533	9301

7590 07/01/2004

James B. Myers Jr.
Woodard, Emhardt, Naughton, Moriarty & McNett
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/01/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,023

Applicant(s)

BRANCH ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/04 has been entered.

Priority

The first paragraph of the specification should read as follows:

The present application is a (continuation) or (continuation-in-part) of US patent application serial number 09/698,623, filed October 27, 2000, and a (continuation) or (continuation-in-part) of US Patent Application Serial Number 09/181,353, filed October 28, 1998, now U.S. Patent Number 6,174,311, and a (continuation) or (continuation-in-part) of US Patent Application Serial Number 09/701,933 which is the national stage of international Application Number PCT/US98/17769, filed August 27, 1998.

In addition, a new declaration is required, since the priority was not properly set forth. The simplest fix would be not to indicate the claims to priority at all, since

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they are all to US applications and the information will be correctly reflected in the first paragraph of the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 63-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Bianchi et al. (6,033,438).

With respect to claims 63, 106, Bianchi et al disclose a spinal fusion implant comprising an elongate bone portion defining a longitudinal axis, and having a generally rectangular cross-section transverse to the longitudinal axis; as set forth in column 8, lines 43-51, the bone portion comprising a first bone engaging surface, a second bone engaging surface; and a first side wall extending between the first and second bone engaging surfaces, as set forth in column 8, lines 13-27, wherein the first side wall comprises a concave surface; as best seen figures.

With respect to claims 64-81,89-92,Bianchi et al disclose all the limitations, the shape of the sidewalls, ridges or teeth on the engaging surface, an end wall having a recess or a threaded bore, or a groove, adapted to engage

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an implant holder; as set forth in columns 7-8, lines 1-68 and in column 8, lines 43-51.

With respect to claim 82, Bianchi et al disclose a spinal fusion implant comprising an elongate bone portion defining a longitudinal axis, as best seen in FIG.16, and comprising, a first side wall comprising a concave surface, a second side wall comprising a convex surface generally parallel to the concave surface; as best seen in Fig.13, a first bone engaging surface positioned between the first and second side walls, and a second bone engaging surface opposite the first bone engaging surface; as best seen in Fig. 8-14, wherein at least one of the first or second bone engaging surfaces comprises ridges or teeth; as set forth in column 7, lines 50-64.

With respect to claim 83, Bianchi et al disclose all the limitations, as best seen in FIGS. 13.

With respect to claim 84, Bianchi et al disclose a system for spinal fusion of adjacent vertebrae, the system comprising a pair of spinal implants; as best seen in FIGS. 8,9, the spinal implants comprising an elongate bone portion defining a longitudinal axis and having a generally rectangular cross section transverse to the longitudinal axis; as set forth in column 8, lines 43-51; a first bone engaging surface, a second opposite bone engaging surface, and a first side wall extending between the first and second bone engaging surfaces , the first side wall comprising a concave portion (FIGS.8,9) the pair of implants are positioned in an intervertebral space whereby the concave portions define a chamber; as best seen in FIGS.8,9.

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With respect to claims 85-88, Bianchi et al disclose all the limitations; as best seen in FIGS.8, 9, and as set forth in column 17, lines 1-50.

With respect to claim 94, Bianchi et al disclose an implant (500,500') for implantation in a disc space between adjacent vertebrae, the implant formed of bone and comprising: a first end (501) having a tool engagement recess and an opposite second end (503), a first bone engaging surface and an opposite second bone engaging surface (FIGS 8,9) a first side wall disposed between the first end and the second end and extending from the first bone engaging surface to the second bone engaging surface; a second side wall opposite the first side wall, wherein the implant has a generally rectangular cross section; as set forth in column 8, lines 43-51.

With respect to claims 85-88, Bianchi et al disclose all the limitations; as best seen in FIGS.8, 9, and as set forth in column 17, lines 1-50 and as set forth in column 8, lines 43-51.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,728,159

03-1998

Stroeve et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
June 24, 2004


PEDRO PHILOGENE
PRIMARY EXAMINER